REMARKS

The present application has been reviewed in light of the Office Action dated July 18, 2008. Claims 1-5, 9-36, and 38-50 are presented for examination, of which Claims 1 and 38 are in independent form. Claims 1, 20, 38, 42, 44, and 48-50 have been amended to define Applicants' invention still more clearly. Favorable reconsideration is respectfully requested.

Claims 49 and 50 were objected to for informalities. In particular, the Office Action states that those claims refer to a method claim instead of referring to a system claim. Claims 49 and 50 have been amended to refer to a system claim. Accordingly, it is believed that the objection has been obviated, and its withdrawal is therefore respectfully requested.

Claims 1, 20, 38, 42, 44, 48, and 50 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have carefully reviewed and amended Claims 1, 20, 38, 42, 44, 48, and 50, as deemed necessary, with special attention to the points raised in sections 8 and 9 of the Office Action. It is believed that the rejection under § 112, second paragraph, has been obviated in view of the claim amendments and its withdrawal is respectfully requested.

The Office Action rejected Claims 1-4, 9-36, and 38-50 under 35 U.S.C. § 103(a) as being unpatentable over by U.S. Patent No. 6,907,566 ("*McElfresh*"); rejected Claims 39-41 and 45-47 under § 103(a) as being unpatentable over *McElfresh*, in view of U.S. Patent No. 6,018,718 ("*Walker'718*"); rejected Claims 3, 4, and 24-36 under § 103(a) as being unpatentable over *McElfresh*, in view of U.S. Patent Application Publication No. 2001/0018665 ("*Sullivan*"); rejected Claims 42 and 48 under § 103(a) as being unpatentable over *McElfresh*, in view U.S. Patent No. 6,598,024 ("*Walker'024*"); rejected Claims 5, 43, 44, 49, and 50 under § 103(a) as being unpatentable over *McElfresh*, in view of Official Notice. Applicants respectfully traverse

these rejections and submit that amended independent Claims 1 and 38, together with the claims dependent therefrom, are patentably distinct from the cited art for at least the following reasons.

On page 4, the Office Action states:

> . . . McElfresh also discloses in at least column 7, lines 8-13, the RAD server requests possible ads or content material from the ad content database based upon information about the particular user. The ad/content database then returns the possible ads for placement on the webpage that fit the particular characteristic of the user. Further more, McElfesh, in at least column 2, lines 56-62 discloses in context to an internet based system for presenting customized ads to users based on users' traits.
>
> It would have been obvious to one of ordinary skill in the art at the time of the invention that McElfresh's system of using the RAD server for retrieving and presenting customized ads to consumer based on their characteristics and the context of presenting the customized (modified) offers over the Internet is equivalent in functionality to Applicant's invention using a retrieved engine to retrieve an offer and then using the presentation engine to modify (customize) the offer based on the offree's trait and the context in which the offers are to be presented.

(Emphasis added.)

The Office Action apparently reaches the conclusion that the features of *McElfresh* are equivalent to the recitations of Claim 1. *See* the underlined text above. Applicants have carefully reviewed *McElfresh* and are unable to agree with the Office Action's characterization of that reference for at least the following reasons.

McElfresh simply does not modify elements within advertisements in any way after selection. As pointed out by the Office Action, *McElfresh* does appear to optimize an ad or set of ads to be presented to a user. That optimization however, does not occur through modifying elements 1) within a particular advertisement and 2) after selection. Instead, *McElfresh* optimizes advertisements by selecting and placing existing advertisements from a central database on a webpage to maximize a click-through-percentage for a particular user. *See*

McElfresh, Col. 2, lines 56-66 and Col. 3, lines 7-19. Nothing has been found in *McElfresh* to teach, reasonably suggest, or even allude to a "presentation engine . . . configured to receive the one or more retrieved offers from the retrieval engine and then modify at least one element of at least one retrieved offer based on an offeree's trait **and** a context in which the one or more retrieved offers are to be presented," as recited by Claim 1 (emphasis added).

A review of *Walker'718*, *Sullivan*, and *Walker'024*, has failed to reveal anything that, in Applicants' opinion, would remedy the deficiencies of the art discussed above, as applied against the claims herein.

For at least these reasons, Applicants submit that the Office Action has failed to sufficiently establish a *prima facie* case of obviousness against Claim 1, and that the various proposed combinations of *McElfresh*, *Walker'718*, *Sullivan*, and *Walker'024*, even if deemed legally permissible or technically feasible, would fail to arrive at the method of Claim 1. Accordingly, the rejection under 35 U.S.C § 103(a) is deemed obviated, and its withdrawal is respectfully requested.

Independent Claim 38 recites similar features as those discussed above with respect to Claim 1 and is believed to be patentable for at least the same reasons as discussed above with respect to Claim 1.

The other rejected claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Because each dependent claim also is deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for this Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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